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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,659	09/03/2004	Hans Lautenschlager	WAS0654PUSA	4816
22045	7590	12/13/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			ZIMMER, MARC S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,659

Applicant(s)

LAUTENSCHLAGER ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Herzig et al., U.S. patent # 6,093,782. Herzig et al. disclose a crosslinkable composition (column 2, line 19 through column 3, line 47) that is useful as a coating material for conferring release characteristics upon a substrate (column 8, lines 50-53). Relevant to the present discussion, component (B) of the prior art composition comprises a compound B¹ that equivalent to the antimisting additive outlined in claim 14. See column 3, line 48 through column 4, line 12, column 6, lines 4-44, and column 7, lines 40-67 where a process of making component B¹ that is identical to the process of making component (X) of the instant invention is described. Significantly, it is stated in column 10, lines 32-36 that, where longer processing times are sought, it is acceptable to also provide other organosilicon compounds, B², bearing hydrosilyl groups. Component B² of the reference composition is analogous to component (B) of the claimed composition.

Concerning claims 14-21, it is appreciated that the reference never explicitly discloses the effect reported by the present disclosure, i.e. the antimisting capabilities of B¹. Nevertheless, the reference discloses (i) the formation of a compound corresponding to the anti-misting compound of the instant invention, and (ii), the

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addition of that compound to a coating composition. Both of the steps recited in claim 14 are expressly stated in the reference and, thus, B¹ will inherently suppress misting when a composition comprising (A), (B²), (C), and (D), is coated onto a surface.

Moreover, the courts have held that, "a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As an aside, there are a number of disclosures, most of which are assigned to the same entity as is the present application, that teach anti-misting compounds sharing similar structural attributes with that presently claimed. Herzig et al., U.S. patent # 6,764,717, for instance, discloses the preparation of an antimisting compound wherein the first step of the preparative approach coincides exactly with the first step of the process employed to make the antimisting compound presently contemplated. However, whereas the antimisting compound of the instant invention is either that realized upon completing said first step, or where a second synthetic step entails equilibration of the intermediate obtained in the first step with an organopolysiloxane of defined structure, the prior art antimisting compound is one obtained by reacting the product of the first step with an alkenyl group-terminated polydiorganosiloxane via hydrosilylation. Clark et al., U.S. patent # 6,489,407 teaches a mist-suppressing

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compound derived from a diene and an organohydrogensiloxane, as opposed to a triene or tetra-ene and organohydrogensiloxane. See also Herzig et al., U.S. patent Application Publication Serial no. 2003/0055194.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 9, 2005

Marc Zimmer
Marc Zimmer
AU 1712